



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/853,753	05/14/2001	N. Torben Bech-Hansen	45499.2	6888

22828 7590 12/04/2002

EDWARD YOO C/O BENNETT JONES
1000 ATCO CENTRE
10035 - 105 STREET
EDMONTON, ALBERTA, AB T5J3T2
CANADA

EXAMINER

CHERNYSHEV, OLGA N

ART UNIT	PAPER NUMBER
----------	--------------

1646

DATE MAILED: 12/04/2002

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/853,753

Applicant(s)

BECH-HANSEN, N. TORBEN

Examiner

Olgaz N. Chernyshev

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 8-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 8-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Claims 4-7 and 15-24 have been cancelled and claims 1, 2, 9 and 11 have been amended as requested in the amendment of Paper No. 14, filed on July 18, 2002. Claims 1-3 and 8-14 are pending in the instant application.
2. The Text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Any objection or rejection of record, which is not expressly repeated in this action has been overcome by Applicant's response and withdrawn.
4. Applicant's arguments filed on July 18, 2002 have been fully considered but they are not deemed to be persuasive for the reasons set forth below.

Claim Rejections - 35 USC § 112

5. Claims 1-3 and 9-14 stand rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention for reasons of record as applied to claims 1-7 and 9-14 in section 7 of Paper No. 12.

Applicant submits that "the one example [of the DNA] is representative of the class being claimed" and that "by describing several different naturally occurring mutant variations of the NYX gene, Applicant has demonstrated possession of naturally occurring variants of SEQ ID

Art Unit: 1646

NO: 2" (see page 3, last two paragraphs of Response). These arguments have not been found to be sufficient to overcome written description requirements of 35 U.S.C. 112, first paragraph.

The invention is drawn to a genus of DNA molecules, while the instant specification only describes a nucleic acid molecule of SEQ ID NO:1 and degenerate variants thereof, which encode a protein which has the amino acid sequence of SEQ ID NO:2 and fails to teach or describe any other DNA which lacks the nucleic acid sequence of SEQ ID NO:1 and encodes a protein which has functional characteristics of a polypeptide of SEQ ID NO:2. Therefore, there is a lack of guidance or teaching regarding structure and function because there is only a single example provided in the specification and because there is no guidance found in the prior art. Furthermore, the instant specification does not provide a complete structure of the claimed DNA molecules or recite any characteristics coupled with a known or disclosed correlation between function and structure sufficient to describe the claimed invention in such full, clear, concise and exact terms that a skilled artisan would recognize applicant was in possession of the claimed invention. Therefore, the claims are directed subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

6. Claims 1-3 and 9-14 also stand rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the DNA molecule having the nucleotide sequence of SEQ ID NO:1, does not reasonably provide enablement for any other DNA molecules for reasons of record as applied to 1-7 and 9-14 in section 8 of Paper No. 12.

Art Unit: 1646

Applicants traversal of the rejection is limited to the statement that “[I]t is submitted that the full scope of [this] claim [1] is fully enabled and described in accordance with 35 USC 112, first para” (page3, first paragraph of Response). The Examiner maintains the position fully explained in the previous office action (section 8, Paper No. 12).

Claim Rejections - 35 USC § 102

7. Claims 1-3 and 8-10 stand rejected under 35 U.S.C. 102(a) as being anticipated by Bech-Hansen et al. (2000, Nature genetics, 26, pp.319-323, reference AB of the Paper No.1) for reasons of record as applied to claims 1-4, 6, 8-10 in section 16 of Paper No. 12.

Applicant submits that Bech-Hansen et al. reference is not prior art because the instant application claims priority to Canadian Patent Application (page 2, section 1 of Response). Until certified copy is submitted for examination as required by 35 U.S.C. 119(b), the instant claims stand rejected.

Conclusion

8. No claim is allowed.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

Art Unit: 1646

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olga N. Chernyshev whose telephone number is (703) 305-1003. The examiner can normally be reached on Monday to Friday 9 AM to 5 PM ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on (703) 308-6564. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 782-9306 for regular communications and (703) 782-9307 for After Final communications.

Certain papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax center located in Crystal Mall 1 (CM1). The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)0. NOTE: If Applicant *does* submit a paper by fax, the original signed copy should be retained by Applicant or Applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers.

Official papers filed by fax should be directed to (703) 308-4556 or (703) 308-4242. If either of these numbers is out of service, please call the Group receptionist for an alternative

Application/Control Number: 09/853,753


Page 6

Art Unit: 1646

number. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294. Official papers should NOT be faxed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Olga N. Chernyshev, Ph.D. DC
December 3, 2002


JOHN TILM
PRIMARY EXAMINER
GROUP 1800